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BAKER & BOTTS
2001 ROSS AVENUE
DALLAS, TX 75201

EXAMINER

MYHRE, JAMES W

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/470,582
Filing Date: December 22, 1999
Appellant(s): SOLOMON ET AL.

Kurt M. Pankratz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 12, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on April 12, 2004 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1, 2, 4-14, 16-26, 28-31, and 40-46 (Group 1) and claims 32 and 34-38 (Group 2) do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

6,039,244	FINSTERWALD	3-2000
6,450,407	FREEMAN et al	9-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4-14, 16-26, 28-32, 34-38, and 40-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finsterwald (6,039,244) in view of Freeman et al (6,450,407).

Claims 1, 8, 9, 12, 20, 21, 24, 32, 36, 40, and 43: Finsterwald discloses a system, apparatus, and method for processing rebates, comprising:

- a. A promotion database describing various rebate offers received from sponsors (col 2, lines 46-65 and col 3, lines 57-62);
- b. A transaction database describing purchases made by customers of one or more merchants (col 2, lines 46-65 and col 3, lines 57-62);
- c. Receiving rebate a rebate request from a customer, the request including at least the customer's identity, the identity of the product for which the rebate is requested, and the identity of the corresponding transaction (e.g. customer name and address/account number, the UPC code for the rebated product, and the transaction/receipt number of the corresponding purchase)(col 2, lines 46-65; col 8, lines 19-21; and col 8, line 54 - col 9, line 44); and
- d. Providing a status report of a rebate to the customer (col 10, lines 21-25).

However, Finsterwald does not explicitly disclose generating promotion reports for the sponsors. Freeman discloses a similar system, apparatus, and method for processing rebates and further discloses generating promotion reports for the sponsors (11, lines 16-29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to generate promotion reports for the sponsors in Finsterwald. One would have been motivated to generate such reports for the sponsors in view of Finsterwald's disclosure that maintaining demographic and transaction histories for the customers and for generating targeted messages based on such an information. Generating reports for the sponsors of these promotional programs would enable the sponsor to ascertain the effectiveness of various types of programs and, thus, target future promotional programs even better.

Claims 2, 16, 28, 41, and 42: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 1, 8, 20, and 40 above, and Finsterwald further discloses a plurality of rebate payment options available to the customer (col 2, lines 25-33 and col 6, lines 28-31).

Claims 4, 11, and 23: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 1, 8, and 21 above. Finsterwald further discloses that it is customary "to send data or addresses via the postal route" (col 2, lines 8-10). Likewise Freeman also discloses allowing the customer to mail in the request form (col 3, lines 53-59). While Finsterwald discusses the advantages of not having to send the data via the postal route, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the customer in

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Finsterwald to mail in the rebate form instead of submitting it over a communication line such as the Internet or telephone system. One would have been motivated to allow the customer to mail in the rebate form in order to give the customer one more (well known) way to submit the data, especially if the customer is away from home (e.g. on vacation) and does not have access to an Internet connection nor telephone line (e.g. in a foreign country).

Claims 5, 13, 25, and 38: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 1, 8, 24, and 32 above, and Freeman further discloses the promotion reports includes all pertinent information about the rebate program, such as number of rebates, breakage rate, name and addresses of requestors, etc. (col 11, lines 16-29). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to generate promotion reports including the above information to the sponsors in Finsterwald. One would have been motivate to generate such reports for the sponsors in view of Finsterwald's disclosure that maintaining demographic and transaction histories for the customers and for generating targeted messages based on such an information. Generating reports for the sponsors of these promotional programs would enable the sponsor to ascertain the effectiveness of various types of programs and, thus, target future promotional programs even better.

Claim 6: Finsterwald and Freeman disclose a system for processing rebates as in Claim 1 above, and Finsterwald further discloses the customer receiving a status report on a submitted rebate request (col 10, lines 21-25).

Claims 7, 14, and 26: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 1, 8, and 20 above, and Finsterwald further discloses receiving verification/approval of the rebate request and that the disbursement of the rebate may take several forms. However, neither reference explicitly discloses receiving the selection of the rebate disbursement type from the customer. Official Notice is taken that it is old and well known to solicit a selection of a disbursement method from the receiver. For example, lottery winners are asked to select between at least two disbursement methods: lump sum of cash, or an annuity. Likewise, taxpayers due a refund are asked to select either a direct deposit of the refund to a financial account or to receive a physical refund check through the postal mail. Finally, customer due a refund when returning a purchased item to a store are often given the choice of a cash rebate or a credit to their store credit account. Therefore, it would have been obvious to one having ordinary skill in the art to allow the customer in Finsterwald to select the desired disbursement method from among the several types of rebates disclosed by Finsterwald. One would have been motivated to allow the customer to select the disbursement method in order to provide greater customer service thereby increasing customer satisfaction with the system.

Claims 10, 22, and 37: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 9, 21, and 36 above, and Finsterwald further discloses receiving the information over a network, such as the Internet (col 8, line 19 - col 9, line 44).

Claims 17, 29, and 34: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 16, 28, and 33 above, and Finsterwald further discloses various disbursement options comprise a cash rebate and a credit voucher ("e-cash" and "rights of use of specific Internet services", i.e. a credit voucher for the Internet services)(col 2, lines 25-33 and col 6, lines 28-31).

Claims 18, 30, 35, and 44: Finsterwald and Freeman disclose a system, apparatus, and method for processing rebates as in Claims 16, 20, and 32 above, and Freeman further discloses the promotion including a product identifier, an end date for the promotion, and a geographic target for the promotion (col 10, line 48 - col 11, line 15). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include such information in the promotion within Finsterwald. One would have been motivated to include the product identifier, an end date for the promotion, and a geographic target for the promotion in view of Finsterwald's disclosure of storing similar types of data, such as "the nature of the product or of the service, to the place of production or the point of sale, to the time of production or the time of sale and/or the price of the product or of the service" (col 3, lines 3-6) and customer-specific data such as "the name, the postal address, the telephone number, the age, the sex and/or the profession of the customer" (col 5, lines 12-16) and for using such data for targeted advertising which is selected based on the stored data (col 6, lines 46-48).

Claims 19 and 31: Finsterwald and Freeman disclose a method and apparatus for processing rebates as in Claims 8 and 20 above, and both references further

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disclose the transaction information including personal information of the purchaser and the purchase information (Finsterwald, col 2, lines 46-61 and col 4, lines 30-42)(Freeman, col 20, lines 53-59).

Claim 45: Finsterwald and Freeman disclose an apparatus for processing rebates as in Claim 43 above, and Finsterwald explicitly discloses that the promotion requirements include a proof of purchase ("the code handed out with the product or with the service serves to show that the customer has actually purchased the relevant product or the relevant service", i.e. a proof of purchase)(col 2, lines 46-49).

Claim 46: Finsterwald and Freeman disclose an apparatus for processing rebates as in Claim 43 above, and Finsterwald further discloses that the promotion requirements include a rebate request form including the rebate transaction identifier (col 1, lines 42-65 and col 7, lines 56-60). While Finsterwald does not use the word "form" to describe the submission by the customer when requesting a rebate, it is disclosed that the customer provides the code and characteristic data about the customer to the data collection point via the internet. A common way to submit information over the Internet is to use HTML forms. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an HTML form when the customer in Finsterwald submits the required rebate information. One would have been motivated to use a form in order to guide the customer, thus ensuring receipt of the required information.

(11) Response to Argument

(A) The Appellant argues in reference to Group 1 (using apparatus Claim 8 as the exemplary claim for the group) that the references do not disclose rebate status updates and that Finsterwald teaches away from the claimed status aspects because the reference does not disclose "any rebate request transaction that remains pending such that status updates would be appropriate" (pages 6-7). The Examiner notes that, as the Appellant discussed, Finsterwald discloses that the customer can request status information about his account. It is also disclosed that the Finsterwald system not only maintains a database of pending rebates along with their rebate codes, but also maintains information about which rebate codes have been used so as to prevent a customer from claiming the same rebate more than one time. Thus, the system is changing the status of the rebate (and rebate code) from pending (issued) to redeemed (used). Since this information is stored in the same system which maintains the customer's account status information and since the customer has access to this status information, it is inherent that the customer can be provided with access to any of the information stored in the system. Granting such access to the information is a design decision by the system operators who may set any limits or no limits on access to the databases. Per Appellant's argument that since Finsterwald immediately credits the rebate amount to the customer upon processing the rebate request there is no need to store a rebate status code, the Examiner notes that since the Appellant's invention also uses a computer system to automatically process the rebates, it too would only maintain a rebate status for a few milliseconds, at most, while the processor completed the

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rebate transaction. Like Finsterwald the Appellant's invention could maintain a status of "paid" once the rebate had been processed. As discussed above, Finsterwald does disclose maintaining a database of pending and redeemed rebate codes, thus disclosing at least two status states for the rebate. The Examiner further notes that upon reviewing all of the claims in this group, Claims 40 and 41 provide the most complete description of the "rebate request status" as "detailing current status of the request for the rebate". Again, Finsterwald's disclosure of maintaining a database which indicates whether a specific rebate code has been redeemed or is still pending reads on this limitation. As per the Appellant's argument that the customer is not allowed to access the database of codes, the Examiner agrees. The customer in either the current application or in Finsterwald would enter the rebate code in question and receive the status back from the database. In neither case would the customer be allowed to browse through the database freely, since it contains a plurality of rebate requests (and codes) from many other customers as well. Indeed, Finsterwald explicitly discloses that the customer on a subsequent visit "simply identifies himself with reference to a code number allotted in the context of the first contact" (col 9, lines 23-26).

The Appellant argues that Finsterwald does not disclose generating promotion reports for sponsors (pages 9-10). The Examiner notes that Finsterwald discloses using the collected data for such purposes as determining "the amount of time which elapses between the manufacture and the sale of the product" (col 5, lines 28-30), targeting advertisements to the individual customer (col 6, lines 40-53), and that "This

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data can be utilized in the initially likewise described manner by the offeree of the products or services purchased by the customer 14, in particular for the adaptation of the respective marketing strategy or for the transmission of advertising messages” (col 10, lines 5-9). Thus, it is implied that the collected data is being sent (reported) to the sponsors of the targeted advertisements and/or manufacturers. While it is not explicitly disclosed that this information being sent to each of the sponsors or manufacturers is being sent in a promotion report format, Freeman discloses storing similar type of information in a database at the Affinity Operator location and that “the Affinity Operator may provide the rebate issuer with a reconciliation showing additional amounts due the Affinity Operator or any refunds redemptions that occurred” (col 11, lines 17-29). The Examiner has interpreted the reconciliation being provided to the rebate issuer as a report which the Affinity Operator has generated for the rebate issuer. Thus, it would have been obvious for Finsterwald to send the collected data to the sponsors or manufacturers using a report format. One would have been motivated to send the data in a report format in order to alleviate the need for each sponsor and manufacturer to “number crunch” the data to produce useful information, which Finsterwald discloses as being used by the sponsors and manufacturers for adapting marketing strategies and advertisements.

The Appellant continues to argue Group 1 on pages 10-11, but switches from using Claim 8 as the exemplary claim for the group to Claims 40 and 43. The Appellant argues that “the Examiner has failed to address specific aspects of Claims 40 and 43” such as the transaction information including “a rebate transaction identifier assigned in

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response to a request for a rebate received from the consumer [and] rebate request information indicating a rebate request materials submission date" (page 10). Initially, the Examiner notes that while this limitation is in Claim 40, it is not in Claim 43. However, Claim 46 does add this limitation to its parent claim, Claim 43. Furthermore, the Examiner notes that Finsterwald discloses the code being associated with information such as "the nature of the product or service, to the place of production or the point of sale, to the time of production or the time of sale and/or to the price of the product or the service" (col 3, lines 2-6). This same code is used when the customer later contacts the data collecting station (col 5, lines 24-59). Thus, a rebate transaction identifier is being assigned by Finsterwald which may include at least the date of manufacture and the date of sale (rebate request).

In the final argument in reference to Group 1 (pages 11-12) and again in reference to Group 2 (page 14), the Appellant argues that "there is no motivation in the cited references or in the knowledge available to one of skill in the art to combine *Finsterwald* and *Freeman*." The Appellant argues that since the two references provide for different types of payments to consumers – cash vs points, there is no need for Finsterwald to maintain payment records. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

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USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references pertain to process rebates on purchased products or services, both references further disclose tracking and storing data pertaining to the customer and the rebate. Therefore, it would have been obvious to one attempting to set up a rebate processing system to select one or more features from one reference to combine with features from the other reference. The Applicant argues that Finsterwald would have no motivation to maintain records for potential audits as disclosed by Freeman. However, the Examiner notes Finsterwald explicitly discloses that the consumer "can then be cashed in in different ways to the advantage of the customer....to change the collected points into e-cash, to purchase rights of use of specific Internet services with the collected points, or to participate in exclusive competitions" (col 2, lines 24-33), and that "This reward can, for example take the form of a credit of a certain amount of money (e-cash), or can take place by granting certain Internet shopping rights, or by granting user rights which can be exploited via the Internet" (col 6, lines 28-31). Thus, Finsterwald discloses in at least two instances that the reward can be money, as in the rebate system of Freeman. The Examiner further notes that depending upon the laws of local jurisdiction where the Finsterwald system resides the system operator may not only be motivated to maintain financial records, but required to do so by law. Even without such a legal requirement for maintaining financial records, it would have been obvious to keep such records for a wide variety of purposes, such as audits, tax filings, profitability determination, etc....all normal activities undertaken by businesses, thus rendering the combination of Finsterwald and Freeman

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very obvious. The Appellant argues against the above motivation to combine, which was presented in the Response to Argument section of the final office action, by claiming that the Examiner did not cite any specific laws pertaining to the legal requirements to maintain financial records by a business and that, in any case, Finsterwald did not have any financial records to maintain. The Examiner refers the Appellant to the voluminous rules and regulations enacted by the United States Internal Revenue Service (IRS) which very explicitly cover how to set up, maintain, and report financial records for every type of business, whether for-profit, not-for-profit, or non-profit, and for each individual taxpayer of this country. Finsterwald's system is not running in a vacuum, but is explicitly awarding cash or other monetary value rebates to customers who may then use the value in other transactions.

(B) The Appellant argues in reference to Group 2 that the references do not disclose an user interface which a user may utilize to create a promotion for a product bearing a rebate (pages 13-14). The Examiner notes that the claimed interface has 4 limitations: 1) display a plurality of fields...; 2) receive promotion information...; 3) communicate promotion information to a remote rebate processing center; and 4) receive a status of the promotion.... Finsterwald discloses that the offerees (users) generate the specific codes, which include such information as the nature of the product, the place of production, the time of production, etc. (col 3, lines 2-6 and 63-67), and then transmits these codes (and the information) to a central position (data collection station. This disclosure reads on steps 2) and 3) above. While it is not explicitly disclosed that the user is entering the information into displayed fields as in

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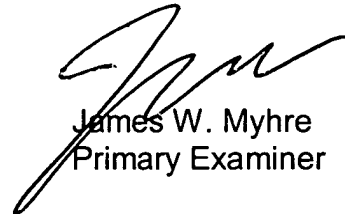
step 1) above, such data entry means for user interfaces are almost universally used throughout the computer industry for defining coupons, pictures, webpages, forms, and documents such as this Examiner's Answer, which displays fields and requests the user to place data in each field. Such data entry means is used to ensure, not only that all the required data is entered, but also that the data is placed in the correct position on the final product. The Examiner also notes that the exact method used by the promotion creator to enter the promotional data does not affect the rebate processing steps of the Appellant's invention. It is inherent in Finsterwald, as in every other coupon or rebate or promotional generating system, that the user must enter the promotional data before it may be stored either locally or remotely, as in Finsterwald. The final step of the claim, step 4), is disclosed by Finsterwald as the data collecting station storing the time of data transmission by the customer which the manufacturer can use to determine "the amount of time which elapses between the manufacture and the sale of the product" (col 5, lines 25-30). The collected data is also used by the sponsors and manufacturers in Finsterwald to target future promotions and advertisements, further supporting the rejection of this step.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



JWM
August 25, 2004



James W. Myhre
Primary Examiner

Conferees:

Eric Stamber 

Yehdega Retta 

BAKER & BOTTS
2001 ROSS AVENUE
DALLAS, TX 75201